

DOCKET NO: 241978US0



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HUGUES VANDENMERSCH, ET AL. : EXAMINER: MANOHARAN, V.
SERIAL NO: 10/647,241 :
FILED: AUGUST 26, 2003 : GROUP ART UNIT: 1764
FOR: THERMAL SEPARATING :
PROCESS BETWEEN AT LEAST ONE
GASEOUS AND AT LEAST ONE LIQUID
STREAM, OF WHICH AT LEAST ONE
COMPRISES (METH)ACRYLIC
MONOMERS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Advisory Action of October 11, 2006, the final Office Action of May 25, 2006, and the Office Action of January 19, 2006, and further to the Amendment filed on August 25, 2006, Applicants request pre-appeal review of the rejections of the present application.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

Applicants submit that the rejection of the claims of the Amendments filed on March 14 and August 26, 2006 as obvious under the meaning 35 U.S.C. § 103 over Matsumoto (U.S. 6,294,056) in view of Yu (U.S. 6,345,811); the rejection of the claims of the Amendments filed on March 14 and August 26, 2006 as indefinite under the meaning 35 U.S.C. § 112, second paragraph; and the objection to the Amendment of August 25, 2006 on the ground of new matter, each contains clear legal and/or factual errors meriting withdrawal of the rejections and the allowance of all now-pending claims.

Applicants submit that the Office failed to identify sufficient motivation to combine the prior art references in view of the prior art's "teaching away" from the claimed invention. For example, the Advisory Action of October 11, 2006 did not address Applicants' arguments traversing the obviousness rejection in view of Matsumoto and Yu (pages 7-10 of the August 25, 2006 Amendment). Applicants' arguments of the August 25 Amendment pointed out that the claimed process, i.e., a process that is carried out with sieve trays operated with an entrainment fraction of above 10% by weight, cannot be rendered obvious by a combination of references that teach away from the claimed invention.

For example, the Office cited Yu as support that the prior art discloses processes wherein the entrainment may be as much as 10%. In rebuttal, Applicants' arguments of the August 25 Amendment pointed out that Yu states that the efficiency of the prior art process is reduced when entrainment is 5-10%. As Applicants' arguments of the August 25 Amendment further pointed out, Yu teaches that increasing entrainment leads to decreasing efficiency. Thus, it would make no sense whatsoever to consider Yu's teaching as a suggestion to operate at high entrainment (e.g., entrainment of greater than 10% as presently claimed) because Yu teaches inefficiency would result.

Applicants submit that combining Matsumoto with Yu is legally incorrect because Yu teaches away from the presently claimed invention. Applicants submit that the Office's rejection of the claims in view of Matsumoto and Yu is therefore legally incorrect and should be withdrawn.

Further with regard to the rejection of the claims as obvious, the Office improperly did not consider Applicants' rebuttal in the form of a discussion of the benefits of the claimed invention and an explanation of the data provided in the original specification (page 9, line 9 - page 10, line 16 of the Amendment of August 25 and page 5, line 18 - page 6, line 10 of the Amendment of March 14, 2006). Applicants submit that the Office's response to the March 14 Amendment (pages 3 and 4 of the May 25 Office Action) provides no comprehensible legal basis for the obviousness rejection and draw the Office's attention to page 7, line 1 through page 10, line 16 of Applicants' August 25 Amendment.

Withdrawal of the rejection is respectfully requested.

The Advisory Action of October 11, 2006, rejected the amended claims of the Amendment filed on August 25 for new matter and/or indefiniteness on the ground that the term "feeding" in line 5 of amended Claim 1 is not supported by the specification. The Amendment of August 25 pointed to page 4, lines 4-11 of the specification as support. In fact, line 9 of page 4 of the original specification uses the word "feed" to describe a liquid added to a separating column.

In addition to the above-mentioned support for the term "feeding", further support is found, for example, on page 2, lines 38-40; page 5, lines 1-5; page 5, lines 15-17; and page 15, lines 17-19 of the present specification. Applicants submit that Office's assertion that the term "feeding" is not supported by the original specification is factually incorrect and thus the rejection and/or objection on the ground of new matter should be withdrawn.

The Advisory Action of October 11 further objected to the August 25 Amendment on the ground amended Claim 11 does not provide antecedent basis for the term “the product gas mixture” recited on line 3. Applicants draw the Office’s attention to M.P.E.P. § 2173.05(e) which states, in part:

Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. (Citations omitted.) Inherent components of elements recited have antecedent basis in the recitation of the components themselves.

Applicants submit that not only would those of skill in the art be readily able to ascertain the scope of Claim 11, any catalytic gas phase oxidation inherently provides a product gas mixture. Because the term “the product gas mixture” is an inherent element of a gas phase oxidation, Applicants submit that, according to M.P.E.P. § 2173.05(e), this limitation has antecedent basis in the term “gas phase oxidation”.

With regard to the rejections for indefiniteness presented in the Office Action of January 19, 2006, Applicants draw the Office’s attention to the arguments of the August 25 Amendment beginning on page 5, line 2 through page 6, line 19 which Applicants submit render any indefiniteness rejections moot.

Applicants submit that the rejections under 35 U.S.C. § 112, second paragraph are legally and/or factually unsupportable. The Amendment of August 25, 2006 should therefore be entered and the rejections withdrawn.

For the reasons discussed above, including (A) the Office’s clear legal errors, e.g., (i) the Office’s improper combination of references where at least one of the references teaches away from the claimed invention, (ii) the Office’s failure to consider the evidence of the original specification when determining whether the claimed subject matter was obvious, (iii) the Office’s rejection of a claim for failing to provide antecedent basis for a claim term that is

an inherent element of a claim term, and further in view of (B) the Office's factual errors, e.g., the Office's assertion that the original specification does not provide support for the term "feeding", Applicants submit that the rejections in the present application are not supportable and should be withdrawn.

Further with respect to the Advisory Action, the Office stated that the August 25 Amendment was not entered on the ground that it raised new issues for consideration. However, the August 25 Amendment addresses the rejection for indefiniteness presented in the final Office Action of May 25 and, Applicants submit, does not raise any new issues for consideration and should be entered.

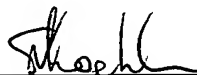
Allowance of all now-pending claims is respectfully requested.

Respectfully submitted,

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